

REMARKS

The Examiner has finally rejected this application on the First Action after the Request for Continued Examination. The Examiner states that the claims are all directed to the same invention as in the application prior to the Request for Continued Examination so are properly finally rejected. However, Claims 4-6 directed to specific bag dimensions were previously dependent on Claim 1 which was directed to sack base perimeter and sack collar height and did not include the lighter weight paper requirement of Claim 2, and there were no other claims of commiserate scope. Therefore, Claims 4-6 claim specifically different inventions. New Claims 12-17 are directed to the combination of lighter weight paper and collar height and do not include base perimeter. Therefore, claims of those specific scopes were not in the application and represent claims to specifically different inventions. Therefore, applicant requests withdrawal of the final action in this case.

The Examiner has rejected Claims 2-7 and 10-17 under 35 USC 112 as failing to particularly point out and distinctly claim the subject matter of the invention. The Examiner pointed to several phrases in Claims 2, 11, and 12 which he thought were unclear. Applicant proposes to amend Claims 2, 11, and 12 to clarify them by further defining or providing antecedent basis for the objected to phrases.

The Examiner has rejected Claims 2-7 and 10-17, all claims of the application, under 35 USC 103 as unpatentable over the admitted prior art. The admitted prior art is that there are standard plastic grocery sacks in widespread use and there are standard paper grocery sacks in widespread use. In order to be strong enough to satisfactorily hold groceries, 1/6-barrel standard paper grocery sacks are made of 70-75 lb. paper and 1/8-barrel standard paper grocery sacks are made of 57 lb. paper. Further the height of the standard paper grocery sacks are greater than the height to the collar of open standard plastic grocery sacks. Generally, either standard paper grocery sacks are used or standard plastic grocery sacks are used. The admitted prior art relied on by the Examiner is that there is a trend in supermarkets for consumers to request that a standard

paper grocery sack be placed as a liner in a standard plastic grocery sack. This gives the advantage of the handles for easier carrying of the standard plastic sack with the structural rigidity of the standard paper sacks, i.e., the standard paper sacks will stand up on a surface such as in a car or on a kitchen counter. However, it is pointed out that the greater height of the standard paper grocery sacks in relation to the standard plastic grocery sacks tends to interfere with the handles of the standard plastic sacks and makes the handles harder to use. A concern of supermarkets is that the standard paper sacks are very expensive, about three times as expensive as the standard plastic sacks. Thus, the admitted prior art is that some consumers ask for standard paper grocery sacks to be placed in standard plastic grocery sacks, thereby using the standard paper grocery sacks as liners for the standard plastic grocery sacks. However, in that instance, the standard plastic grocery sack is merely acting as a holder or carrier for the standard paper grocery sack. Each sack is working separately. The standard paper grocery sack is carrying the groceries and the standard plastic grocery sack is carrying the paper sack.

Claims 2, 11, and 12 are now proposed to be amended to specifically recite that the paper container is not strong enough to itself alone hold groceries that would normally fit into the container. This clarifies the significance of the lighter weight paper. The lighter weight paper sack cannot be used alone on its own as a normal grocery sack.

There is no suggestion in the admitted prior art that anything other than standard paper grocery sacks be placed in standard plastic grocery sacks. There is no suggestion in the admitted prior art that a special paper liner be made for use as a liner of standard plastic grocery sacks, or as to how a special liner might be different than the standard paper grocery sack. There is no suggestion that anything other than the standard paper grocery sack be used as the liner or that there would be any desire by anyone to have anything other than the standard paper grocery sack as a liner if a liner is to be used. With a standard paper grocery sack, the sack can be used alone as a paper grocery sack or can be used in combination with a standard plastic grocery sack as a liner if specifically requested by the consumer. There is no suggestion that a paper liner be developed that

specifically works with and supplements a standard plastic grocery sack in a synergistic way to allow the advantages of a standard plastic grocery sack to be used and also obtain the benefits of a standard paper grocery sack, but at a reduced expense to the supermarket.

A significant part of applicant's invention is the realization that there might be an advantage to having a special paper liner for standard plastic grocery sacks even though this liner might not be usable as a grocery sack on its own if the consumer only wanted a paper grocery sack. In addition, an important aspect of the invention is the discovery, once it is realized, that special paper liners for standard plastic grocery sacks might be advantageous, that the advantages of a standard paper grocery sack as a liner are maintained with a lighter weight of paper than normally used in standard paper grocery sacks (cannot be used alone as a grocery sack), that this lighter weight paper has its own advantages (less cost), and that a shorter sack (less capacity than a normal paper grocery sack) is acceptable and works well to provide full use of the handles provided on the plastic sack. Further, if the base perimeter of the paper liner is approximately equal to the perimeter of the standard plastic grocery sack with which it is used as a liner, the shorter height still allows use of the full capacity of the standard plastic grocery sack.

Applicant's invention, in line with those realizations, provides a light weight paper liner, a liner made of a lighter weight paper than would be used for a standard paper grocery sack and that could not be used alone as a grocery sack, and a liner having a height shorter than the standard paper grocery sack so that the liner fits into the standard plastic grocery sack and the handles of the standard plastic grocery sack can be easily used without interference from the paper liner. To make the lighter paper liner work efficiently, the liner preferably has a base perimeter approximately equal to the base perimeter of the standard plastic grocery sack with which it is used so as to use the full carrying capacity of the standard plastic grocery sack. When a paper liner is placed in the standard plastic grocery sack, the standard plastic grocery sack tends to conform to the paper liner to surround and reinforce the lighter weight paper that is used, thus allowing use of the lighter weight paper and the resultant cost savings in paper. There is absolutely no suggestion

in the admitted prior art or other prior art that such a paper liner can be successfully used as a liner for a standard plastic grocery sack.

The Examiner states that "It would have been obvious . . . to use a grade of paper between 35 lbs. and 50 lbs. . . . since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice." The statement requires that, to be obvious, the suitability for the specific use must be known. Here, the use is a sack made of paper to be used as a liner for a standard plastic grocery sack. The prior art used standard paper grocery sacks as liners. This teaches use of the same weight paper as the standard paper grocery sacks. Thus, before a lighter weight paper than that being used in the prior art would be selected by a worker in the art as suitable for the intended use, it would have been known that lighter weight paper would be suitable for and could be used for the intended use. Here, there is absolutely nothing in the prior art to indicate or suggest that the lighter weight paper that could not be used for a stand alone paper grocery sack would be satisfactory for such use.

Neither the use of lighter weight paper that produces a sack that cannot be used as a stand alone paper sack nor the reduced height of the liner is suggested by the admitted prior art, nor is the combination of the two suggested. Applicant submits that none of the pending claims are made obvious by the cited art and that such claims should be allowable.

Favorable reconsideration is respectfully requested.

Respectfully,

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